

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

McStay et al.

International Application Number: PCT/EP2005/002270

Serial Number: 10/591,611

International Filing Date: 2 March 2005 (02.03.2005)

Filing Date: September 5, 2006

Title: **FLUOROMETER**

**PETITION UNDER 37 C.F.R. 1.47(a) FOR FILING WHEN AN INVENTOR
REFUSES TO SIGN**

Commissioner for Patents
Attn: Petitions Examiner - PCT Legal
P.O. Box 1450
Alexandria, VA 22313-1450

10/17/2007 LLANDGRA 00000031 10591611

Sir:

01 FC:1463

200.00 DP

Petitioner, through the undersigned attorney, hereby requests that the captioned application for patent be made by the other inventors on behalf of themselves and the non-signing inventors, since two of the four inventors, refuse to join in this application for patent.

This invention was internationally filed on 2 March 2005 as PCT/EP2005/002270 and entered the national phase in the US Under 35 U.S.C. 371 on 5 September 2006. Four inventors were declared for the entry into the US. Two of the four inventors have refused to sign the Declaration/Power of Attorney that was presented to them as described below.

Statement of Facts:

- 1) The four US inventors of this invention are 1) Daniel McSTAY, 2) Anton FORTE, 3) Khalid THABETH and 4) Terrence

GREENAWAY. Together, the four inventors participated in the invention of the present application which was filed as a PCT International Application on 2 March 2005 as PCT/EP2005/002270. A Declaration as to Entitlement to Apply for and Be Granted a Patent was filed in the Request indicating all inventors were employees of Smart Light Devices Ireland Limited.

- 2) Instructions were given to The Nath Law Group by Mr. Allan Wallace of F.R. Kelly & Co. of Belfast, North Ireland, Great Britain, to proceed with national phase entry in the US.
- 3) On 5 September 2006, the international application entered the national stage in the U.S. under 371 without an executed inventors Declaration/Power of Attorney. On 14 May 2007, a Notification of Missing Requirements Under 371 was mailed by the US PCT Office to The Nath Law Group, the agents representing the applicant in the US.
- 4) The Nath Law Group timely forwarded the notice to the F.R. Kelly & Co.
- 5) Subsequently, F.R. Kelly informed The Nath Law Group that not all the US inventors would sign the declaration/power of attorney.
- 6) Mr. Wallace mailed letters with a copy of the Patent application and the declaration to each of the U.S. inventors on July 16, 2007. He received back 2 executed declarations but did not receive executed declarations from Mr. Forte or Mr. Greenway. A Statement of First-Hand Knowledge is provided by Mr. Wallace of the sequence of events as **Annex A** and is described as follows.
- 7) A copy of the letter to Mr. Forte dated July 16, 2007 by recorded delivery is attached as **Annex B**. The letter indicates that a complete copy of the specification and drawings along with the declaration form were provided to Mr. Forte.

- 8) The electronic proof of delivery by Royal Mail to Mr. Forte is provided in **Annex C**.
- 9) Mr. Wallace further describes in his statement (No. 4) that Mr Forte contacted him by telephone on 24 July 2007 and stated he would decline to sign the form.
- 10) A copy of the letter to Mr. Greenaway dated 16 July 2007 by recorded delivery is attached as **Annex D**. The letter indicates that a complete copy of the specification and drawings along with the declaration form were provided to Mr. Greenaway.
- 11) On 26 July 2007, Mr. Greenaway contacted Mr. Wallace via email and indicated that he declines to sign the Patent Application. A copy of the email is attached as **Annex E**.

Items submitted herewith:

- 1) Transmittal Letter;
- 2) Copy of Notification of Missing Requirements Under 35 U.S.C. 371;
- 3) Petition for 3 month Extension of Time;
- 4) Executed Declaration signed by two of the four inventors;
- 5) **This Petition Under 37 C.F.R. 1.47(a) for Filing When an Inventor Refuses to Sign;**
- 6) Annex A, Statement by Mr. Alan Wallace, a person with firsthand knowledge;
- 7) Annex B, Copy of letter to Mr. Forte by recorded delivery on July 16, 2007;
- 8) Annex C, Proof of Delivery to Mr. Forte by Royal Mail Recorded Delivery;
- 9) Annex D, Copy of letter to Mr. Greenway by recorded delivery on July 16, 2007;
- 9) Annex E, email of 26 July 2007 from Mr. Greenway;
- 10) Check No. 5057 \$ 200.00 for Petition Fee Under 37 CFR 1.17(g);
- 11) Check No. 5058 \$ 525.00 for 3 month extension of time fee as a small entity;
- 12) Check No. 5059 \$ 65.00 surcharge for late filing of executed Declaration.

It is respectfully requested that Daniel McStay and Khalid THABETH be permitted to make application on behalf of themselves and the non-signing inventors, Anton FORTE and Terrence GREENAWAY.

MAIL STOP PCT MISSING PARTS

Attorney Docket No. 27667U

Petition for Non-Signing Inventor

Page 4

The last known address of the non-signing inventors are:

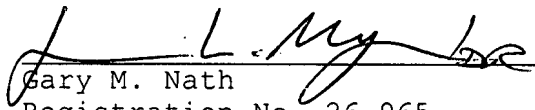
- 1) Mr. Anton FORTE
9 Watermead Avenue
Greyabbey
Co Down BT22 2XA United Kingdom

- 2) Mr. Terry GREENAWAY
14 Gilnahirk Rise,
Belfast, BT5 7DT United Kingdom

Should there be any deficiency in fees or credit for any overpayment in connection with this matter, please charge to our deposit Account No. 14-0112.

Please direct any questions or comments to the undersigned attorney.

Respectfully submitted,
THE NATH LAW GROUP


Gary M. Nath
Registration No. 26,965
Jerald L. Meyer
Registration No. 41,194
Customer No. 20529

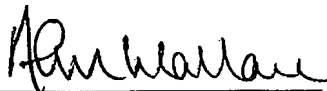
Date: October 15, 2007
112 South West Street
Alexandria, VA 22314
Phone: (703) 548-6284
Fax: (703) 683-8396
GMN/JLM/dd:Pet.1.47(b)NonSigningInv

Annex A

IN THE MATTER OF
United States Patent Application Serial No. 10/591,611
Daniel McStay et al
Attorney Docket No. 27667U

1. I, Alan Wallace, am a European Patent Attorney who instructed Nath & Associates to file the above-identified US Patent application. It has been my responsibility to attempt to obtain the inventors' signatures on the Declaration for Patent Application form
2. I have managed to obtain signatures from Daniel McStay and Khalid Thabeth, but have been unable to obtain signatures from Anton Forte or Terry Greenaway.
3. On July 16, 2007, I wrote to the inventors Anton Forte and Terry Greenaway providing them with a copy of the patent specification and asking them to review the specification and to sign the Declaration form. A copy of each letter is enclosed. The letters were sent by Royal Mail Recorded Delivery.
4. By way of proof of delivery, I enclose an extract from the Royal Mail website showing that my letter was delivered to Anton Forte's household on July 17, 2007. The Royal Mail's website is unable to provide me with corresponding proof of delivery for my letter to Terry Greenaway. However, I enclose an email from Mr Greenaway which confirms that Mr Greenaway did receive my letter.
5. On July 24, 2007, Anton Forte contacted me by telephone. He explained that it was too long since he was involved in the project which gave rise to this invention and that he did not feel that he was in a position to make any declaration concerning the accuracy of the specification. He therefore declined to sign the form.
6. On July 25, 2007, Terry Greenaway contacted me by telephone. Mr Greenaway also declined to sign the declaration form on the basis that it was too long since he was involved in the project and he felt that he could not verify the accuracy of the specification. Mr Greenaway followed up our telephone conversation with an email on July 26, 2007 (copy enclosed) confirming his decision not to sign the form.

Signed: _____



September 6, 2007

ALAN WALLACE



F. R. KELLY & CO.

EUROPEAN PATENT ATTORNEYS • COMMUNITY TRADE MARK ATTORNEYS

Annex B

To avoid unnecessary delay,
please quote our reference!

Mr Anton Forte
9 Watermead Avenue
Greyabbey
Co Down
BT22 2XA

Your Ref : --
Our Ref : P69829US00//MOC/AW/am

RECORDED DELIVERY

July 16, 2007

Dear Mr Forte

**United States Patent Application Serial No. 10/591,611
Out of International PCT Patent Application number
PCT/EP2005/002270 "Flurometer"**

The above-identified US Patent application has been filed in respect of the flurometer developed by Smart Light Devices Ireland Limited. The US Patent application has been derived from the International PCT Patent Application No. PCT/EP2005/002270 which was filed in the name of Smart Light Devices Ireland Limited.

The United States Patent and Trade Mark Office require that each of the inventors sign a declaration form in which they declare that they are first and joint inventors of the subject matter which is claimed in the Patent application. In the present case, you have been named as one of the inventors.

I enclose a declaration form together with a copy of the Patent specifications and drawings. I should be very grateful if you would read the Patent specification, sign and date the declaration form in the space provided, and return the form to me at the address below. For your convenience I have enclosed a stamp-addressed envelope. Alternatively, you could return the form to me by fax or email.

We have been given until **August 14, 2007** to have this form returned to the USPTO.

I would be grateful if you would return the signed form to me a good time before then.

If you have any queries in relation to this, please do not hesitate to contact me.

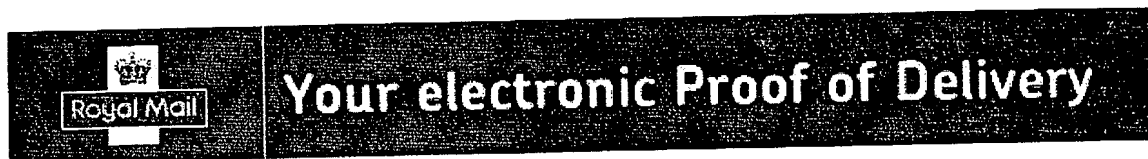
Thank you for your assistance

Yours sincerely

Alan Wallace


Enc.

Annex C - page 1 of 2



Your item with reference DH271203231GB was delivered from our NEWTOWNARDS Delivery Office on 17/07/

Electronic Proof of Delivery for your item

DH 2712 0323 1GB SIGNED FOR	Print Name
	X. H. ALISON FOR
Time	Check time & sign
930	X. H. ALISON 7

Close window

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DH 2712 0323 1GB SIGNED FOR



Print Name

X *Travis Ford*

Check time & sign

Time

930 *Xallan Ford*



F. R. KELLY & CO.

EUROPEAN PATENT ATTORNEYS • COMMUNITY TRADE MARK ATTORNEYS

To avoid unnecessary delay,
please quote our reference!

Annex D

Mr Terry Greenaway
14 Gilnahirk Rise
Belfast
BT5 7DT

Your Ref : --
Our Ref : P69829US00//MOC/AW/am

RECORDED DELIVERY

July 16, 2007

Dear Mr Greenaway

**United States Patent Application Serial No. 10/591,611
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I enclose a declaration form together with a copy of the Patent specifications and drawings. I should be very grateful if you would read the Patent specification, sign and date the

4 Mount Charles, Belfast BT7 1NZ, Northern Ireland • Telephone +44-28-9023-6000 • Fax: +44-28-9023-5454 • post@frkelly.co.uk • www.frkelly.com
GERALD KINSELLA* PHILIP COYLE* LINDSAY J. CASEY* BRENDA O'REGAN SHANE SMYTH* ASSUMPTA DUFFY* MAURA O'CONNELL* GAVAN FERGUSON DAVID BROPHY* CONOR BOYCE* ALAN WALLACE* MARY BLEAHENE

OLIVER FENTON BRIAN O'NEILL* TARA JENNINGS* BRONWYN O'HAGAN NIAMH HALL MADELEINE KELLY HAZEL TUNNEY PAUL HUSSEY SUMI NADARAJAH

Consultants: Peter F. Kelly* Neil McVeigh John P. Richards

OFFICES AT DUBLIN AND ATLANTA

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If you have any queries in relation to this, please do not hesitate to contact me.

Thank you for your assistance

Yours sincerely

Alan Wallace

Enc.

Alan Wallace

From: tgreenaway@ntlworld.com
Sent: 26 July 2007 19:29
To: Alan Wallace
Subject: Smart Light Devices Patent Application

Annex E

Allan

Regarding the Smart Light Devices Patent Application Documentation (Ref P69829US00/MOC/AW/am) that you sent to me, I do not want to be included on the Patent Application and decline your request to sign the Patent Application.

Terry Greenaway

Email sent from www.virginmedia.com/email
Virus-checked using McAfee(R) Software and scanned for spam